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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG D. YARDLEY, CHESTER W. GOODING, JR.,
and BYRON E. BURRIER

Appeal 2009-001146
Application 10/689,379
Technology Center 3700

Oral Hearing Held: June 25, 2009

Before LINDA E. HORNER, JOHN C. KERINS, and MICHAEL W. O'NEILL, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

ROBERT C. STANLEY, Attorney at Law
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The above-entitled matter came on for hearing on Thursday, June 25, 2009, commencing at 10:45 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Leanne M. Krivonak, Notary Public.

PROCEEDINGS

THE CLERK: Good morning. Calendar Number 64, Appeal Number 2009-1146, Mr. Stanley.

JUDGE HORNER: Thank you.

THE CLERK: You're welcome.

JUDGE HORNER: Good morning, Mr. Stanley.

MR. STANLEY: Good morning.

How are you?

JUDGE HORNER: Do you have a business card you might be able to provide to the court reporter?

MR. STANLEY: Of course.

JUDGE HORNER: Thank you.

So we've had a chance to review your case and we're ready and so you've got 20 minutes and you can start when you're ready.

MR. STANLEY: Okay. Well, you just ask me questions, that will be fine.

No, I think we have an interesting case. It's not often that I get a chance to argue what about means, but there's a lot of confusion essentially as to how about is used in these claims. And so I think getting rid of some of the 112 rejections up front will help us resolve some of the prior art problems later. So that's what I would like to start with.

JUDGE HORNER: Good.

MR. STANLEY: As you see we have two groups of claims. Claim 1 is exemplified by independent claim 80 which essentially recites a single-ply napkin that has a machine direction and a cross machine direction, and we'll

get to those terms as well, where the machine direction is in the longitudinal dimension and the cross direction -- the across machine direction is in the transverse dimension and it's folded. These are method claims.

We've already gotten our product claims in an earlier patent that issued back, I think, in 2001 or 2002 and so here we're focusing on the method. So there is folding involved and the folding results in absolutely no folds in the longitudinal direction and only folds or really transverse folds in the machine direction.

And that's very important as described in our specification because previously for napkins in the prior art there was really no recognition that you could use folds in that manner to create napkins that had significantly better properties over the prior art.

JUDGE KERINS: Counsel, if I may real quick, you just mentioned transverse folds in the machine direction?

MR. STANLEY: Yes.

JUDGE KERINS: Don't you mean folds transverse to the machine direction?

MR. STANLEY: There's an odd way of saying it at lot of times. There's a difference between transverse folding or folds in the transverse direction because they create different things. I'm going to try to be consistent and I apologize, but when there are transverse folds for the purposes of our claims, they are in the machine direction.

JUDGE KERINS: The fold itself is transverse in the machine direction?

MR. STANLEY: I believe that's right.

JUDGE KERINS: The crease?

MR. STANLEY: And actually, if it please the Board, I have a small demonstrative that is made up of nothing more than disclosure and specification that shows an exemplary napkin with the different dimensions and shows where all of these dimensions are explained in the specification and it might be helpful if we could all refer to it, as I speak.

I've got multiple copies, if anyone would like to take a look, but I think it does clarify the point that you're making.

JUDGE HORNER: Did you say it's in the specification?

MR. STANLEY: It's not in the specification, but it's made up of a disclosure all in the specification and so all I did was take and draw essentially an exemplary napkin as we claimed it on the piece of paper; and I have noted the machine direction, the cross machine direction, the transverse dimension, the longitudinal dimension and I've shown an exemplary fold so that essentially everything becomes a little bit more clear instead of trying to get bound up by what could be some very confusing terminology.

JUDGE HORNER: Okay, we'll allow.

MR. STANLEY: Okay. Great.

And I also brought copies as well because -- in case we want it into the permanent written record, I have no objection to that, as well.

Here you are, sir.

JUDGE O'NEILL: Thank you.

JUDGE HORNER: Thank you.

JUDGE KERINS: Thank you.

MR. STANLEY: Thank you.

So I think as you can see here, we've got the -- we have an exemplary napkin. The transverse free edge or the edge that's in the transverse

dimension is shorter than the edge that's in the longitudinal direction that's also in the machine direction. And so the machine direction sounds down the page, the cross machine direction extends across the page and the fold is along a transverse edge. So they call it a longitudinal or it's folding longitudinally because you're going in that direction, but as a transverse fold because it is along the transverse free edge.

I don't know how these paper makers do it, but this was all very apparent to them when I talked them about it earlier. So that's why I drew this out so I could try to make sure I would get it right.

JUDGE HORNER: Okay.

MR. STANLEY: And as I mentioned, the prior art significantly usually had napkins that only -- that either folded in two directions or only folded in a cross machine direction and I think a lot of that was because prior napkins were built using paper folders and other types of technologies to where it required a cross direction fold instead of machine direction fold.

And we described in our specification that we found ways to modify conventional napkin folders so that they do not have any longitudinal folding and they have only folding in the transverse direction, and I think that's around paragraph 80 in the corrected specification that we had to submit to use paragraph numbers.

And actually just to further my demonstratives, I brought a napkin that I found in my firm's cafeteria this morning and indeed it has -- it's folded into four panels and it's folded in two different directions and so it has both a machine direction fold and a cross machine direction fold or a transverse fold and a longitudinal fold.

One of the other interesting parts about this case is the linkage between the different dimensions that we've discussed and the machine direction and the cross machine direction.

There has been some confusion, I think, during examination as to whether or not machine direction and cross machine direction refer only to directions of essentially the paper traveling through a standard paper making machine or if indeed webs produced by standard paper making machines inherently have machine directions and cross machine directions.

And I believe it's clear from our specification that they do. We speak in several places about a machine direction or a cross machine direction of the web, which divorces the -- those directions from the paper making process itself and shows that indeed our inventors contemplated and indeed one of ordinary skill in the art recognized that webs themselves have machine direction and cross machine direction.

We talk in the briefs also about sidedness. Sidedness is interesting. It does result in things like differences in tensile strength direction, which is what is talked about in our specification, but you can see it, if you take a normal one-ply napkin because if you try to tear it, it's like tearing newspaper. If you tear it in the machine direction, it tears evenly. If you tear in the cross machine direction which is against the grain of the paper fibers as they're laid down on the forming wire, it doesn't tear in the same direction.

JUDGE KERINS: So, Counsel, I didn't see in your specification anywhere where you termed machine and cross machine direction in terms of fiber orientation; it's certainly not in the claims.

MR. STANLEY: Well, I'll grant you, it's not necessarily in the claims. We do talk about the fact that you -- that our webs are made on standard paper making machines and then the webs are laid down on to a wire and that indicates to one who skilled in the art that you will have fibers that will lay down on the wire and the wire moves in a particular direction.

So inherently the fibers lay down in that direction as to they go along the wire to be processed further in the paper making machine.

JUDGE KERINS: So, Counsel, for example, your claims don't require that this all be happening on the machine continuously. So you could get a bunch of paper web blanks that meet the limitations otherwise.

Can you determine what the machine direction is if I just handed you a stack of paper web blanks?

MR. STANLEY: Yes, I can because essentially these napkins, let's say, would be made by paper web blanks, and a skilled artisan probably uses a little bit more of a scientific test than this tearing test, but essentially you can test the paper.

In the machine direction -- if I can get it open, in the machine direction, it will tear evenly and then the cross-machine direction, it won't. Yes, in the cross-machine direction, it will not.

So and there is many other napkins that do the exact same thing. I actually pulled one out of you-all's cafeteria earlier this morning that was dispensed. It also has two folds, but it's a little bit more rectangular and it does the exact same thing. In one direction it tears unevenly, the cross machine direction, and then in the machine direction, it tears evenly.

So and, of course, there are other ways to figure it out, but that's an easy one to demonstrate here.

JUDGE KERINS: Counsel, in the case where, one example given in your specification, you have tensile strengths which are equal in both the machine and cross-machine directions.

MR. STANLEY: Yes.

JUDGE KERINS: Would that change the demonstration that you've given us here?

MR. STANLEY: It could. I'm not necessarily overly familiar with tensile strength. There's lots of different ways to measure strength. There is wet strength, there's dry tensile strength. We talked there. I do believe that tensile strength may have some indication and may have some effect on the tearing, but you can also do microscopic tests. I mean, there is lots of different ways to test and turn out if your -- or to see if your web happens to be anisotropic, as they call it, or nearly square.

But even then the specification emphasizes that it approaches a one-to-one ratio or that it's nearly square. I'm not aware of any web that can be produced that is entirely square because of the way paper machines work, which is when you lay the fibers down on wire that's moving intrinsically some of those fibers are going to start traveling in that direction. So it also might be dependent on the types of fibers you use and the chemicals that you use indeed; and there's many different processes and things involved in paper making.

JUDGE KERINS: If I may. Counsel, can we move on to what you brought up at the beginning about --

MR. STANLEY: Oh, sure, yes, definitely.

So we talked about paper making and indeed paper making is a -- it seems to be a precise science, but indeed it's really not, and here we

have -- we've used about consistently throughout the specification to refer to several different numerical embodiments.

First, it talks about the ratio of longitudinal to transverse dimensions. Then it also talks about a basis weight, which is, you know, how heavy the paper is once it's manufactured. We also talk about individual links; and about is a completely normal word to use during patent prosecution.

I'm sure the panel is fully aware of many patents that have been issued and been argued that uses the term about; and here I think the problem is that the Examiner is well, conflating the idea that we have at least about a two to one ratio where our specification also in certain embodiments says that those lengths that make up the ratio could also be about.

JUDGE KERINS: Right.

MR. STANLEY: And so, but I take two instances of that, one, those are merely embodiments that say about. We also have examples as shown in table 1 of our specification --

JUDGE KERINS: Counsel, if I could go there, please.

MR. STANLEY: Yes, please.

JUDGE KERINS: I think -- we have in the claim that the claim reads that the longitudinal dimension is at least about two times the transverse dimension?

MR. STANLEY: That's right.

JUDGE KERINS: And I don't think we have a problem once you're at two and beyond two, which many of your examples in table 1 cover.

MR. STANLEY: Right.

JUDGE KERINS: But we have two examples in table 1, the ServRight and the Luncheon 1/4F.

MR. STANLEY: Okay.

JUDGE KERINS: Which if you look at the dimensions provided, give us a 1.85 to 1 --

MR. STANLEY: right.

JUDGE KERINS: longitudinal to transverse ratio.

MR. STANLEY: Well, I will mention that the specification does disclose a ratio that's about 1.7 to 1 or at least about 1.7 to 1 and then also, at least about 2 to 1. So we've represented previously that about does have some dimension and I don't know that about 2 to 1 as we claim it here for this particular application has to reach every single one of the examples that's in Table 1.

JUDGE KERINS: Sir, does it or doesn't it reach that?

MR. STANLEY: Well, you know, again -- you want me to define exactly what about means, and that seems to be converse to why we use the term about the claims.

If I wanted to tell you that about was it meant that it would reach no more than 1.9, then I would just say, 1.9 in the claim. About has to allow some measure of variance as it would be understood by one skilled in the art. So --

JUDGE KERINS: Counsel, I'm not sure that either you or the Examiner addressed the Seattle Box Case.

MR. STANLEY: Okay.

JUDGE KERINS: Where it does discuss the Federal Circuit case says that the specification -- we have an inquiry that whether the specification provides some standard for measuring a term of degree.

MR. STANLEY: That's right.

JUDGE KERINS: Do we have something in the specification here that's a standard for measuring this term of degree?

MR. STANLEY: Well, I believe that here we're just talking about measuring the particular dimensions of the paper web; and I think the specification in -- let me see if I can find my list of where support is -- does say that you simply measure, I believe it's paragraph 70 says that the transverse free edges that as applies to width and the longitudinal free edges that edged upon the length and then a -- oh, here we go. I'm sorry. It's paragraph 78 says the longitudinal dimension and the transverse dimension are measured from one free edge to the other parallel edge.

JUDGE KERINS: I understand that. I'm talking about our end result and how close we are to 2 and whether we're within or without -- to the outside of the claim.

MR. STANLEY: Well, I think that, for example, where one is skilled would understand that about would encompass standard manufacturing tolerances.

And in fact, in an interview with one of the Examiners and -- oh, I'm sorry. With the Examiner and one of the Inventors back in, I believe, 2006 we mentioned that expressly and the Examiner seemed to indicate that yes, that was an acceptable understanding about what about could mean.

But it's also interesting here that we don't necessarily have too big of a problem with about reaching any sort of prior art, or about this value being inherently detrimental to or inherently important overly to the present invention unlike the Amgen case.

JUDGE KERINS: Counsel, if I may, --

MR. STANLEY: Yes.

JUDGE KERINS: -- with respect to the prior art, the Lazar case, you've argued that that shows a ratio longitude to transverse if we accept what the drawing shows of 1.6 to 1, and that's clearly not a 2, about 2 to --

MR. STANLEY: And we say that, that's correct. Well, I think we mentioned that in our brief.

JUDGE KERINS: So it does have an effect on the prior art?

MR. STANLEY: Well, I guess it could, yes. So by saying that -- by indicating that 1.6 is not within about 2, we have put a bound on what about two would mean.

JUDGE KERINS: And did I understand you correctly that when you mentioned a different embodiment where we have a 1.7 to 1 ratio, is it your position that 1.7 to 1 is a separate embodiment and that about 2 doesn't reach 1.7?

MR. STANLEY: I think the specification does seem to indicate that those are two separate embodiments.

Now in terms of litigation later on, I don't know what the litigators are going to do with that argument, but certainly the specification conflates that you can have something as low as 1.7 and you can have something a little bit higher than about 2.

What the intersection crosses between those are not necessarily certain, you mention, of course, the two embodiments of the specification that are about 1.85 to 1. That seems to be exactly between 1.7 and 2. So perhaps that was their thinking when they ran these examples, they picked two things on either side and went from there.

Unfortunately, this case was first filed back in, I believe, 1998 and so it's significantly old at this point and I've lost touch with exactly what the inventors might have intended.

JUDGE HORNER: What's the purpose of the ratio of the length to the width? I mean, is there any implication of that in terms of --

MR. STANLEY: It does. It's most useful for how the product is actually used. When you go to fast food establishments like McDonald's and Euro Cafe, they have these -- our trademark is called Easy Nap. But they have these long cassettes of napkins and annoyingly for us, but conveniently for the proprietor, you can only pull one napkin out at a time. So when you fold it, it's much easier to have a rectangular napkin do that than a square napkin or anything else.

So the two to one ratio gives us a good basis for the rectangle to fold or fold again because, of course, claim 84 and it's dependents have more than one fold. So it gives you a good blank basis to start with and also, avoids the problems as to one and two once the web becomes more square that you need folds in different directions to come up with a napkin that is conveniently sized.

Just like the napkin that I showed previously where indeed the blank web is square, it had to be folded in both a longitudinal and a transverse dimension in order to get a napkin that would be essentially commercially acceptable for people to dispense in a web.

So I think that's one of the reasons why the dimension is particularly -- well, is important here to the claims; and indeed it is recited in the claims.

Once we get back to the prior art as well, when we mention the linkage of the transverse dimension and the longitudinal dimension with the cross machine direction and the machine direction we also then begin to understand why the particular method of folding that's claimed here is useful versus the prior art that uses cross machine direction folding which is inherently slower and less efficient because of either turning the web or the particular ways in which you would have to manipulate the web to orient it for that type of folding.

Lazar, I think you mentioned previously. They are the -- the definitive language appears -- I think it's line 103, back when they used to label these things or number these things sequentially where it talks about interleaving a number of sheets simultaneously. That tells one of ordinary skill in the art that there had to have been cross machine direction folding involved.

And I believe we explained that graphically in our Reply Brief at pages 9 to 10, and we also talk about in our regular Brief at pages 28 to 30.

JUDGE KERINS: Could you spend a minute or two on that thought, please, because I frankly wasn't picking up on where Lazar specifically spoke to that?

MR. STANLEY: Okay. So let me just turn to Lazar. I believe it's column 2. Line 104 talks about a number of such folded sheets are then interleaved with that portion of the sheet adjacent to the single fold such that essentially they begin nesting together.

And if you take a look at the reply brief and actually, I believe, it's page 12, you see how that type of thing would work only with a cross machine direction fold.

Essentially you have to take a very long length of web and then you have to turn it or fold it in the cross machine direction for however many times Lazar needs to be able to do it because only then do you get the ability to simultaneously interleave them together.

If you try to do that at a machine direction, you can't turn and do all of it simultaneously at the same time.

JUDGE KERINS: Counsel, I didn't see where the quoted passage from Lazar necessarily spoke to having to do this simultaneously. It said that they are then interleaved, they may go to a completely different piece of equipment.

MR. STANLEY: Let me see if I've marked it.

Looking back to Lazar, are then interleaved. I thought that there was an operative word.

Let me look at my brief. I apologize.

I believe it's because it talks about the -- it's a number of such folded sheets. So that tells one of ordinary skill in the art that indeed a number of sheets are being done simultaneously. It's not just one at the time. It's numbers of sheets are being done at the same time. And when our inventor actually looked at that specification it was very clear to him because he's familiar with this type of Christmas-tree type folding where you do actually turn it in the machine direction because to get a number of folded sheets all done at the same time, they are then interleaved. You have to use the cross machine direction to be able to nest them all together at one time.

And so that's actually the operative language that I was mentioned.

JUDGE KERINS: Counsel, you couldn't take a stack of your inventive napkins, take them to a station and have them interleaved just like this?

MR. STANLEY: You know, I don't know the answer to that, but my question is no, because quite frankly in the simplest embodiment of our invention you take a -- well, this is not a rectangular embodiment. Let me make a rectangular one here.

If you just fold it once to interleave them, you have to then turn the napkin and you have to turn the next one and turn the next one and turn next one versus being able to actually interleave them all with a number of such folded sheets to be able to achieve the actual folding that's with Lazar where each sheet is nested into each other, that is most conveniently and essentially always done as it would be done with a skilled artisan with a cross machine direction fold so that you can push all those sheets together at one time.

Ours is not necessarily that way; and it's another reason why, I believe our embodiment using one fold that's in the machine direction is novel and non obvious over these references because quite frankly for the napkin arts when you pull it out, let's say, one of these containers at McDonald's or something else, you'll notice the napkin is always kind of facing the exact same direction. It's not interleaved.

So you can load these machines with a presentation style in one fold so that the bottom of the napkin is always facing towards you so to make it easy to dispense. If you were to do something like Lazar, where you had to turn or interleave the napkin, the next one you pull out it would be the cusp or the fold that would be facing you and not necessarily the free edge of the napkin; and that would cut against the teachings that I referenced that talk

about easy, ease of dispensability and also the fact that proprietors much to my chagrin don't want you to be able to grab multiple napkins at the same time. They want you to only take one or two. So that was part of the reason why the interwoven folding of Lazar teaches something that's very much against the machine direction folding that we have of our sheets.

I think the same type of folding is also seen in Chan. Chan, as opposed to a very simple fold like ours where it's one or two folds and they're always in the same direction, Chan has an extremely difficult folding. And I think it's always interesting that Chan never tells you how exactly they fold these darn napkins. They just disclose the fold and I guess the one of ordinary skill has to dream up a way to do it.

I believe that if you -- and our inventors have told me that if you were to do it, and ordinary skilled artisans would do it this way, that you would have to use again cross machine direction folding in a style similar to Lazar simply because of the way the napkin is oriented and the number of different folds you have, particularly because you have not only folds in one direction, but you also have folds in a reverse direction along the same dimension and that is extremely difficult, if you not impossible. Our inventors knew of nothing that could do it, actually only in the machine direction.

So Chan again by its folding, just like Lazar doesn't teach the single fold machine direction style that we have in our claims.

And then we get to the obvious over Ito where instead of folding we really go to the idea that we're not talking about napkins, but we're talking about a much different product which is a four-ply shop wipe. So there things like shrink dimensionability and everything else show one of ordinary

skill that not necessarily those teachings that are involved have anything to do with napkin art.

Making napkins versus toilet paper versus paper towels versus shop wipes all require radically different technologies, paper making machines, chemicals, types of fibers and so forth such that the teachings from one type of paper to the other are not necessarily co-extensive.

JUDGE KERINS: Counsel, we don't have a definition of napkin in the specification, do we, that would exclude other types of paper webs?

MR. STANLEY: Well, I think we do talk very routinely that it is a napkin. I believe we also talk about basis weights. Generally other types of webs are going to have much higher basis weights than were disclosed in our specification.

Also, other types of paper products are usually multiple plies. We have, and we're very explicit, that it's only a single-ply; whereas, let's say, in Ito it's very explicit that it's a 4-ply.

So you are beginning to see differences in what would happen with the strength. I mean, a 2-ply napkin is noticeably stronger usually than a 1-ply napkin. A four-ply shop wipe is going to be noticeably stronger than a two or 1-ply of just about anything else.

JUDGE KERINS: But if the person skilled in the art realizes that he doesn't need the strength of the 4-ply, wouldn't he just cut down the number of plies until he had whatever properties he needed?

MR. STANLEY: Well, the problem is that Ito and our invention are trying to solve very different problems and once you try to modify Ito to take its plies away, you're essentially killing the purpose of Ito which is to

provide the strongest paper product possible for the job which is one of these shop wipes.

And these people use these paper disposal shop wipes to mop up oils and other such things where the skilled artisan would know once they start taking the plies away, they're no longer going to have a product that is useful for the purpose that Ito teaches and that, I think, is very clear in the MPEP that it tends to show that there would be no obviousness in such a situation because the skilled artisan would not want to make that modification.

JUDGE KERINS: Counsel, in Ito, though, we at least do have a clear teaching of the folding in the same direction that you have claimed.

Is that correct?

MR. STANLEY: It is a folding in the machine direction. I think if you look at claim 1 of Ito it shows the paper making machine and it travels along and all of a sudden, they're all scrunched up.

But Ito is interesting in that it never actually makes webs with definable dimensions. If you look at, let's see, I believe it's figure 3 of Ito or even figure 2, it perforates instead of creating webs that actually have directions that could be folded.

So when it folds, it may fold in the machine direction, but it isn't creating a web as we would define it that has a machine direction and a cross machine direction -- oh, I'm sorry. It does have those things.

It doesn't have necessarily a transverse dimension and a longitudinal dimension because the thing is so darn big the way they want to dispense it is you pull off as many as you want and then you just tear.

So I think that it is a little different from the claims. Even though it may be somehow folded, it's not creating discrete webs of anything. It's just

creating a folded, you know, 20 or 30 foot long thing that it collapses down accordion style which is different than our method here and I think that would have been apparent to the skilled artisan.

JUDGE HORNER: All right. Any other questions?

MR. O'NEILL: I have nothing.

JUDGE KERINS: No.

JUDGE HORNER: Thank you for your time.

MR. STANLEY: Thank you very much.

(Whereupon, at approximately 11:10 a.m. the proceedings were concluded.)